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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/841,893	04/25/2001	Charles E. Wheatley III	QCPA453B1C1	6708

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Qualcomm Incorporated
Patents Department
5775 Morehouse Drive
San Diego, CA 92121-1714

EXAMINER

VANDERPUYE, KENNETH N

ART UNIT	PAPER NUMBER
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2661

DATE MAILED: 03/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/841,893

Applicant(s)

WHEATLEY ET AL.

Examiner

Kenneth N Vanderpuye

Art Unit

2661

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-58 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-30, 33, 40-49 and 52 is/are rejected.
- 7) ☒ Claim(s) 31, 32, 34-39, 50, 51 and 53-58 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 21-22, 40-41 are rejected under 35 U.S.C. 102(b) as being anticipated by Choate (5,212,804).

With regards to claims 21, 40, Choate teaches an apparatus for synchronizing a base station with a wireless communication comprising: a transmitter(base station transmitter, Fig. 3), a processor communicatively coupled to said transmitter(Base station controller), and a storage medium coupled to said processor(Tape storage) and containing a set of instructions executable(Fig. 11) by said processor to: disable said transmitter(transmitter is disabled during powerup); and obtain initial timing(Fig. 11@345).

With regards to claim 22, 41, Choate teaches the timing signal provided from a base station controller(central processor, Fig. 11@345)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 23-25, 42-44 rejected under 35 U.S.C. 103(a) as being unpatentable over Choate.

With regards to the above claims Choate fails to teach alternative sources of the timing signal. Official notice is taken that it is well known in the art that timing can be generated remotely or internally, intermittently to save power or continuously. The selection of each kind is based on design considerations. Hence the selection of a timing source is obvious as a matter of design choice.

Claims 26, 45 rejected under 35 U.S.C. 103(a) as being unpatentable over Choate in view of Abreu et al(6,014,367)

With regards to claims 26, 45, Choate teaches a receiver communicatively coupled to said processor(Fig. 11) and configured to receive signals from a mobile station(aircraft). What Choate fails to teach, is the use of signals received from a mobile station to adjust timing. This is

taught by Abreau(Abstract). It would have been obvious to one of ordinary skill in the art to combine Choate with Abreu for the purpose of enabling a base station to receive synchronization from a mobile. The motivation being to use a wireless medium as opposed to a wired medium to establish sync.

Claims 27-30, 33, 46-49, 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Choate in view of as applied to claims 26, 45 above, and further in view of Scott.(5,745,484).

With regards to claims 27-28, 30, 46-47, 49, Choate and Abreu inherently teach obtaining the mobile identity in order to establish communication. What they both fail to teach is estimating the distance, time delay roundtrip delay etc. Scott teaches roundtrip propagation time as the bases for establishing communication with mobile stations(see abstract). The distance is easily estimated based on the round trip delay time. It would have been obvious to one of ordinary skill in the art to combine Scott with Choate and Abreu for the purpose of adjusting timing based on distance. The motivation being to maintain synchronization.

Claims 29, 48 are rejected as being inherently taught because if the mobile is adjacent to the base station, then delay is not a factor.

Claims 33 and 52 are rejected because although Scott teaches commanding the user to adjust timing, he does not teach transmitting the command at increasing power levels. However since the mobile may be in constant motion away from the base station, it imperative that the base station increase power levels in order for the mobile to be able to receive the command signals. Hence it would have been obvious to one of ordinary skill in the art that increasing power levels ensures that the mobile will continues to adjust its timing clock.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 of U.S. Patent No. 6,307,840. Although the conflicting claims are not identical, they are not patentably distinct from each other because: Claims 2-6, 8-9 are identical to claims 2-8 of '840. However claim 1 of the instant application is a broader version of claim 1 of '840 because what has been omitted is "...communicating information from the first base station to the second base station to assist the second base station in receiving communications from the mobile." It has been held that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function same function as before. In re Karlson, 136 USPQ 184(CCPA). Since the function has not been changed claim 1 of the instant application is not patentably distinct from claim 1 of '840.

Claims 11-16, 18-19 are an obvious variation of the method steps in claims 1-6, 8-9 because the apparatus is used to implement the method steps. Hence they are also an obvious variation of claims 1-8 of '084 for the same reasons.

Claims 7, 17 are an obvious variation of claim 6 of '084 because the further away you are from the first base station the closer you are to the second base station. Hence the signal interference is substantially less.

Claims 10, 20 are obvious variation of claims 1,11 because it is inherent that a mobile communicate with a base station based of the round trip delay interval otherwise they would be out of sync.


Allowable Subject Matter

Claims 31-32, 34-39, 50-51, 53-58 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenneth N Vanderpuye whose telephone number is 571-272-3078. The examiner can normally be reached on M-F(7:30-5:00) Second Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chau Nguyen can be reached on 571-272-3126. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



KENNETH VANDERPUYE
PRIMARY EXAMINER

KNV
2/26/05